

10/15



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,072	01/25/2002	Genoveffa Franchini	15280-4003US	1664
7590 04/21/2004			EXAMINER	
Jean M Lockyer Townsend & Townsend & Crew 8th Floor Two Embarcadero Center San Francisco, CA 94111-3834			PARKIN, JEFFREY S	
			ART UNIT	PAPER NUMBER
			1648	
DATE MAILED: 04/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/048,072	Applicant(s) FRANCHINI ET AL.	
	Examiner Jeffrey S. Parkin, Ph.D.	Art Unit 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03132003</u> | 6) <input type="checkbox"/> Other: _____ |

Serial No.: 10/048,072
Applicants: Franchini, G., et al.

Docket No.: 15280-4003US
Filing Date: 01/25/02

Detailed Office Action

Status of the Claims

Applicants' election of Group I (claims 1-10 and 12-17) in the communication filed 08 January, 2004, is acknowledged. Because applicant did not distinctly and specifically point out the purported errors in the restriction requirement, the election has been treated as an election without traverse (refer to M.P.E.P. § 818.03(a)). Claim 11 is withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The information disclosure statement filed 13 March, 2003, has been placed in the application file and the information referred to therein has been considered.

Claim Objection

Claims 1-10 and 12-17 are objected to because of the following informalities: applicants are reminded of the restriction requirement as clearly set forth in paper no. 5. Applicants elected Group I which is directed toward methods of stimulating CD8⁺ HIV **structural** antigen responses through the administration of **nucleic acid-based vaccines**. The claims should be amended to reflect the restriction requirement and election. Appropriate correction is required.

35 U.S.C. § 112, Second Paragraph

Claims 1-10 and 12-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention. Two separate requirements are set forth under this statute: (1) the claims must set forth the subject matter that applicants regard as their invention; and (2) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The reference to an "efficient CD8⁺ response" in an HIV-infected patient is vague and indefinite since it fails to clearly identify the salient characteristics of the CTL response. The claims fail to set forth the specificity and avidity of the CD8⁺ response. The claims also fail to identify which populations of CD8⁺ cells are being "activated" by the claimed methodology (i.e., CTL memory, effector, precursor). The claims fail to specify suitable administration parameters such as the target tissue (i.e., oral, mucosal, muscular), formulation, and vaccination regimens that lead to the desired response. Finally, the reference to administration of a recombinant virus in claims 5-8 is also confusing since the claims are directed toward the administration of a nucleic acid vaccine, not an attenuated virus.

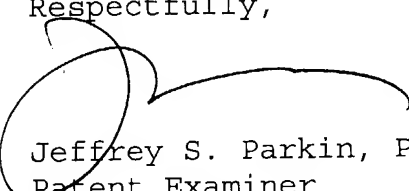
Correspondence

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 9:30 AM to 7:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, Laurie Scheiner or James Housel, can be reached at (571) 272-0910 or (571) 272-0902, respectively. Direct general inquiries to the Technology Center 1600 receptionist at (571) 272-1600.

Formal communications may be submitted through the official facsimile number which is (703) 872-9306. Hand-carried formal communications should be directed toward the customer window

located in Crystal Plaza Two, 2011 South Clark Place, Arlington, VA. Applicants are directed toward the O.G. Notice for further guidance. 1280 O.G. 681. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Respectfully,



Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

16 April, 2004